

47. A method of searching a plurality of financial instruments, said method comprising:

- (a) presenting a plurality of filter parameters for selection by a user;
- (b) based on a selection of one or more of said filter parameters defining a first filter pass, presenting concurrently with said filter parameters a preview of a result of said first filter pass;
- (c) performing said filter pass in response to a user command given after said preview is presented to said user; and
- (d) repeating steps (b) and (c) for at least a second filter pass.

REMARKS

Claims 1-47 are pending in the application. Claims 1-17 and 30-41 have been held withdrawn as being drawn to a non-elected invention. Claims 18 and 42 have been amended. Claim 47 is newly added. Reconsideration of this application is respectfully requested.

Applicant affirms the provisional election with traverse to prosecute the invention of Group I, namely claims 18-29 and 42-46.

The Requirement for Restriction between the method claims of Group I and the apparatus claims of Group II is respectfully traversed. The Office Action supports the requirement by stating that the apparatus as claimed could be used as any financial decision support system. This rationale is erroneous and not in compliance with the Manual of Patent Examining Procedure (MPEP). At section 806.05(e), the MPEP states that the process and apparatus for its practice are distinct if it can be shown that "the apparatus as claimed can be practiced by

another materially different apparatus or by hand.” The Office Action has not shown that the apparatus as claimed can be used to practice another or materially different process. The statement that the apparatus can be used as any financial decision support system is general and omnibus in nature and does not identify “another and materially different process.”

The Office Action rejects claims 18-21, 24-27, 42 and 44-46 under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,774,878 to Marshall, hereafter Marshall.

This rejection is erroneous because Marshall lacks features recited in these claims. With respect to independent claim 18, Marshall lacks steps (b) and (c). Claim 18 has been amended at line 2 to clarify that the method performs a plurality n of filter passes. Step (b) clearly recites that that the proposed filter condition includes the at least one investment parameter selected by the user for the i th filter pass as well as all filter conditions for previously performed ones of the filter passes. Marshall teaches only a single filter pass that defines a virtual reality environment. Step (d) requires that steps (a), (b) and (c) be repeated until the n th filter pass has been performed. Marshall, having a single filter pass, also lacks step (d).

Independent claim 42 has been amended to recite that the groupings of the histogram are frequency of occurrence groupings.

Marshall lacks a histogram as claimed in claims 19 and 42. The Office Action contends that Marshall's Figures 3a-3d show a histogram. Marshall's Figures 3a-3d do not show a histogram as claimed in claims 19 and 42. For example, claim 42 recites that the groupings are frequency of occurrence groupings. Marshall's Figures 3a-3d depict a screen display generated by the virtual reality generator 4. The icon arrangement shown in Figures 3a-3d has nothing to do with frequency of occurrence as recited by claims 19 and 42..

Marshall also lacks the feature that the display elements are bars as recited in claim 45. Marshall also lacks step (d) of claim 48.

For the reason set forth above, it is submitted that the rejection of claims 18-21, 24-27, 42 and 44-46 under 35 U.S.C. 102(b) as anticipated by Marshall is inapplicable and should be withdrawn.

The Office Action rejects claims 22, 23, 28, 29 and 43 under 35 U.S.C. 103(a) as unpatentable over Marshall, as applied to claims 21, 27 and 42, in view of U.S. Patent No. 5,918,217 to Maggioncalda et al., hereafter Maggioncalda.

The Office Action alleges that Marshall shows all of the limitations of claims except for specifying that the parameter and the histogram are displayed on the same screen. This allegation is erroneous because Marshall does not teach making multiple filter passes (base claims 18 and 42) or histograms intervening claim 19 and base claim 42), from which claims 22, 23, 28, 29 and 42 depend, as noted above in the discussion of the rejection under 35 U.S.C. 102 (b). Maggioncalda does not teach these features. Accordingly, for this reason, the conclusion of obviousness is inapplicable to claims 22, 23, 28, 29 and 43.

The Office Action concedes that Marshall does not teach displaying the parameter limiter and the histogram on the same screen. The Office Action states that Maggioncalda teaches (figure 4) a user interface for a financial advisory system where the filter conditions are on the same screen as the resultant bar graph to provide the ease of seeing both without flipping from screen to screen. The Office Action then concludes that it would have been obvious to modify Marshall's virtual reality generator to provide the user interface module on the same viewing screen as the population chart in order to provide the ease of seeing both without flipping from screen to screen.

This conclusion of obviousness is erroneous. There is no suggestion or motivation for one of ordinary skill in the art to modify Marshall's virtual reality generator with a screen similar to that shown in Maggioncalda's Figure 4. Marshall and Maggioncalda are directed to entirely different systems. Marshall discloses a user specified virtual reality generator with a capability to do a single filter pass of financial instruments. Maggioncalda shows a financial advisory system that provides an asset allocation based on user input. Maggioncalda does not teach any filtering or financial instrument screening. Therefore, there is no suggestion or motivation to combine the teachings of Marshall and Maggioncalda.

The Office Action suggestion to use the teaching of Maggioncalda in combination with Marshall is improperly based on the hindsight of Applicant's disclosure. Such hindsight reconstruction of the art cannot be the basis of a rejection under 35 U.S.C. 103. The prior art itself must suggest that modification or provide the reason or motivation for making such modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398-1399 (CAFC, 1989). "The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." Sensonic Inc. v. Aerosonic Corp. 38 USPQ 2d 1551, 1554 (CAFC, 1996), citing Interconnect Planning Corp. v. Feil, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (CAFC, 1985).

For the reasons set forth above, it is submitted that the rejection of claims 22, 23, 28, 29 and 43 under 35 U.S.C. 103(a) is erroneous and should be withdrawn.

The Office Action cites a number of patents that were not applied in the rejections of the claims. These patents have been reviewed, but are believed to be inapplicable to the claims.

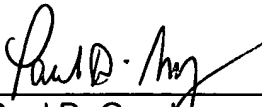
Newly presented claim 47 recites a method of searching a plurality of financial instruments comprising the steps of (b) based on a user selection of one or more filter parameters defining a first filter pass, presenting concurrently with the filter parameters a preview of a result of the first filter pass, and (c) performing the first filter pass in response to a user command given after the preview is presented to the user. Claim 47 also recites the step of repeating steps (b) and (c) for at least a second filter pass. None of the cited references teaches a method having this claimed combination of steps. Accordingly, it is submitted that claim 47 distinguishes from the cited art and is, therefore, allowable.

Attached hereto is a marked-up version of the changes made to the specification and claims by the present amendment. The attachment is captioned "Version With Markings To Show Changes Made."

It is respectfully requested for the reasons set forth above that the rejections under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) be withdrawn, that claims 18-29 and 42-47 be allowed and that this application be passed to issue.

Respectfully Submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

Application, Serial No. 09/389,939

IN THE CLAIMS

Please amend the claims as follows:

18. (Amended) A method of searching a universe of financial instruments by performing a plurality of n filter passes of said universe with a computer having a processor, a memory, a viewing screen and a computer input device, each said filter pass having a filter condition, said method comprising:

(a) presenting on said viewing screen a plurality of investment parameters, at least one of said investment parameters being selectable by user operation of said computer input device as a proposed filter condition;

(b) presenting on said viewing screen a population chart showing the population of said financial instruments in different categories for said proposed filter condition of an i^{th} one of said filter passes, where i is [an] any integer from 1 to n , said proposed filter condition including (a) at least one investment parameter selected by user operation of said computer input device and (b) all filter conditions for previously performed ones of said filter passes;

(c) executing said proposed filter pass in response to a run command generated by user operation of said computer input device; and

(d) repeating steps (a), (b) and (c) until the n^{th} filter pass has been performed.

42. (Amended) A method of searching a universe of financial instruments comprising:

(a) presenting a histogram including a plurality of display elements that represent different groupings of an investment parameter, wherein said groupings are frequency of occurrence groupings;

(b) identifying for each of said display elements a filter condition for said investment parameter; and

(c) presenting an associated actuator for each of said filter conditions for selective actuation by a user.